

**REMARKS**

**INTRODUCTION**

In accordance with the foregoing, claims 1 and 12-17 have been amended, and claims 18 and 19 have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1-19 are pending and under consideration. Reconsideration is respectfully requested.

**REJECTION UNDER 35 U.S.C. §103**

In the Office Action at page 2, numbered item 3, claims 1-17 were rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,208,659 to Govindarajan, et al. The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

**Claims 1, 3, and 12-17**

Independent claim 1 is directed to an advertising method for distributing advertisements to user terminals on a network from an awareness device for managing user status. In relevant part, the advertising method of amended independent claim 1 recites "storing as a user status-setting alternative a symbol representing an advertiser, the symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the advertiser itself." Claim 3 depends directly from amended independent claim 1.

Independent claims 12-17 have been amended to recite similar features. Support for the amendment of claims 1 and 12-17 can be found in the originally filed Specification, at least at paragraphs 0021 and 0159.

Applicants respectfully submit that Govindarajan, et al. fails to teach or suggest at least "storing as a user status-setting alternative a symbol representing an advertiser, the symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the advertiser itself," as recited in amended independent claim 1. Features similar to those of amended independent claim 1 are found in amended independent claims 12-17.

At page 3, the outstanding Office Action acknowledges that Govindarajan, et al. does not disclose that the status symbol represents an advertiser. The Office Action, however, asserts that "It would have been obvious to one having ordinary skill in the art at the time the invention was made that the status symbol selected by the first user could represent any type of entity or non-entity to include an advertiser." Applicants respectfully disagree.

MPEP 2143.01 states that the "fact that references can be combined or modified is not sufficient to establish *prima facie* obviousness." More specifically, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990).

Further, MPEP 2143.03 states that "all claim limitations must be taught or suggested." "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

As Govindarajan fails to teach or suggest at least storing a symbol representing an advertiser, the symbol being provided by the advertiser, as a user status-setting alternative or that the symbol provided by the advertiser is capable of reminding a person of items or services of the advertiser as well as the advertiser itself, Applicants respectfully submit that claims 1, 3, and 12-17, and those claims depending directly or indirectly therefrom patentably distinguish over the prior art. Further, Applicants respectfully submit that a *prima facie* case of obviousness has not been established. For at least these reasons, Applicants respectfully submit that claims 1, 3, and 12-17, and those claims depending directly or indirectly therefrom, are in condition for allowance.

#### **Claim 2**

Claim 2 depends directly from amended independent claim 1. As the rejection of dependent claim 2 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claim 2 patentably distinguishes over the prior art for at least reasons similar to claim 1 and is, therefore, in condition for allowance.

#### **Claim 4**

Claim 4 depends directly from amended independent claim 1. As the rejection of dependent claim 4 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claim 4 patentably distinguishes over the prior art for at least reasons similar to claim 1 and is, therefore, in condition for allowance.

#### **Claim 5**

Claim 5 depends directly from amended independent claim 1. As the rejection of dependent claim 5 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claim 5 patentably distinguishes over the prior art for at least reasons similar to claim 1 and is, therefore, in condition for allowance.

**Claim 6**

Claim 6 depends directly from amended independent claim 1. As the rejection of dependent claim 6 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claim 6 patentably distinguishes over the prior art for at least reasons similar to claim 1 and is, therefore, in condition for allowance.

**Claims 7 and 8**

Claims 7 and 8 depend directly from amended independent claim 1. As the rejection of dependent claims 7 and 8 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claims 7 and 8 patentably distinguish over the prior art for at least reasons similar to claim 1 and are, therefore, in condition for allowance.

**Claims 9-11**

Claims 9-11 depend directly from amended independent claim 1. As the rejection of dependent claims 9-11 fails to cure the deficiencies of Govindarajan, et al. noted with respect to claim 1, Applicants respectfully submit that claims 9-11 patentably distinguish over the prior art for at least reasons similar to claim 1 and are, therefore, in condition for allowance.

**NEW CLAIMS 18 AND 19**

New independent claims 18 and 19 have been added to set forth the invention in varying scope. Support for new independent claims 18 and 19 can be found in the originally filed Specification, at least in paragraphs 0015, 0019, and 0190, and in Fig. 17.

New independent claim 18 is directed to an advertising method for distributing advertisements to user terminals on a network from an awareness device for managing user status. The method includes "storing as a user status-setting alternative a symbol representing an advertiser, the symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the advertiser itself," "accepting from a primary user a request to use the symbol as a self-status designation," "distributing to a user terminal used by a secondary user the symbol representing the primary user's status via the network," and "presenting the symbol on a user terminal used by the secondary user as the primary user's status information to remind the secondary user of the advertiser, its items or its services." Applicants respectfully submit that Govindarajan, et al. fails to teach or suggest all of the features of new independent claim 18.

New independent claim 19 is directed to an advertising method for distributing advertisements to user terminals on a network from an awareness device for managing user status. The method of claim 19 includes "storing as a primary user's status-setting alternative a symbol representing an advertiser, the symbol being originally provided by the advertiser and capable of reminding a person of items or services of the advertiser as well as the advertiser itself," "accepting from the advertiser a request to use the symbol as the primary user's status designation," and "distributing to a user terminal used by a secondary user the symbol representing the primary user's status via the network." Applicants respectfully submit that Govindarajan, et al. fails to teach or suggest all of the features of new independent claim 18.

## CONCLUSION

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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